REMARKS

Claims 1, 2, 4-7, 10, 11, 13-20, 31-38 and 41-51 are in this application. Claims 3, 21-30 and 39 and 40 have been cancelled. Claims 8, 9, and 12 have been withdrawn.

Claim 1 has been amended to delete hydrogen as a definition of R^4. Claims 1, 10-11, 13-20, 47 and 48 have been amended to define Z as O.

Claim 6 has been amended to delete compounds where Z is other than oxygen.

The Examiner states that the compound of formula (I) should be defined so that Y^2 and Y^3 cannot both be hydrogen. However, in the elected species both Y^2 and Y^3 are hydrogen.

Applicants preserve all rights to file one or more divisional applications directed to subject matter disclosed in this application and not presently claimed.

According to the Official Action, claims 1-2, 4-7, 31, 35, 41-46 and 49 are rejected as allegedly obvious in view of Braun et al. This rejection is respectfully traversed.

The claimed compounds are not obvious over Braun because R^1 in formula (I) does not include phenyl or CH_2OH. In addition, Braun shows a compound having two substituted oxazolidinone groups. A compound where only one oxazolidine group is substituted is not obvious from Braun.

It is submitted that the Examiner is relying on impermissible hindsight in making this rejection. According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

> (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the standard with which obviousness is determined.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See Panduit Corp. V. Dennison Manufacturing Co. 227 USPQ 337, 343 (Fed. Cir. 1985):

> It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.

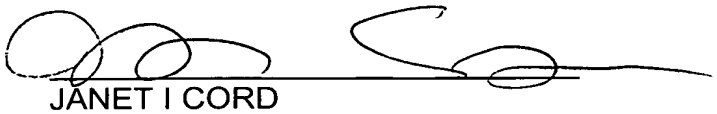
In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. Vandenberg v. Dairy Equipment, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing In re Sponnoble, 160 U.S.P.Q. 237 (CCPA 1969). In Uniroyal . Rudkin-Wiley, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

> The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Since the examiner is relying on impermissible hindsight and because Braun does not suggest the compounds of formula (I), claims 1-2, 4-7, 31, 35, 41-46 and 49 are not obvious over Braun. It is respectfully requested that the rejection be withdrawn.

It is submitted that the application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted,



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